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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,114	11/14/2000	Brian Harniman	3553-4067US1	4946
27123	7590	04/26/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			DIXON, THOMAS A	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/716,114

Applicant(s)

HARNIMAN ET AL.

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-12,14,73-80 and 133-140 is/are pending in the application.
- 4a) Of the above claim(s) 8,13,15-72,81-132 and 141-194 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-12,14,73-80 and 133-140 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08).
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 8 and 13, objected to in the previous action have been cancelled.
2. The replacement drawings submitted 7/16/04 are acceptable as regards the rejections of the previous action, but are non-compliant with the new amendment practice under 37 CFR 1.84, effective 6/30/03 which requires the drawings be identified in the top margin as "Replacement Sheet."
3. Applicant's arguments regarding the 112 rejection are convincing, the 112 rejection is withdrawn.
4. Applicant's arguments regarding the 102 rejection have been considered and are not convincing.

The electronic negotiation with an offer price and a discount incentive of Tavor, see column 2, lines 9-41, is seen to disclose the claimed conditional purchase offer with bounceback offer, and the bounceback further explained, see column 2, lines 55-61 and column 14, lines 5-23.

Specification

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 133-140 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is directed to

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nonfunctional descriptive matter. Though the medium is computer readable, the code is never executed and is code per-se and not statutory subject matter.

7. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

8. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450 U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

9. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

10. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 5, 9-12, 73, 77, 80, 133, 137, 140 are rejected under 35 U.S.C. 102(e) as being anticipated by Travor et al (5,433,347).

As per Claims 1, 73, and 133.

Travor et al ('347) discloses :

transmitting a conditional offer to acquire a first product or service, said conditional purchase offer including a customer-specified price, see column 2, lines 9-33;

receiving an acceptance of said conditional purchase offer and a bounce back offer to acquire a second product or service with a hyperlink to a cobranded web site, see column 2, line 30-61 and column 9, line 46 – column 10, line 32;

accessing said cobranded web site to effectuate said bounceback transaction with a supplier-partner for said second product or service, see column 9, line 46-column 10, line 32.

As per claims 5, 77, 137.

Travor et al ('347) further discloses a jump page, see column 10, lines 30-32.

As per claims 9.

Travor et al ('347) further discloses a making an offer to acquire a second product or service in said cobranded website, see column 9, line 46 – column 10, line 32.

As per claims 10

Travor et al ('347) further discloses receiving an offer to acquire said second product or service in said cobranded website, see column 9, line 46 – column 10, line 32.

As per claims 11.

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Travor et al ('347) further discloses either accepting or rejecting said offer or making a counter offer in said cobranded website, see column 9, line 46 – column 10, line 32.

As per claims 12

Travor et al ('347) further discloses choosing not to make an offer or accept an offer to acquire said second product or service in said cobranded website, see column 9, line 46 – column 10, line 32.

As per claims 80, 140.

Travor et al ('347) further discloses receiving, accepting or rejecting an offer to acquire said second product or service in said cobranded website, see column 9, line 46 – column 10, line 32.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2-3, 74-75, 134-135 are rejected under 35 U.S.C. 103(a) as being unpatentable over Travor et al (5,433,347).

As per claims 2, 74, 134.

Travor et al ('347) is not limited by type of product or service, but does not specifically disclose the second product or service is an automobile rental, hotel reservation or airline ticket.

Official notice is taken that conditional purchase offers for airline tickets, hotel rooms, or rental cars are old and well known in the art, see assignee's reference Walker et al (5,794,207) figure 5 (515) for the benefit of maximizing sales of products or services.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to sell airline tickets in the invention of Travor et al ('347) for the benefit of maximizing sales of products or services.

As per claims 3, 75, 135.

Travor et al ('347) is not limited by type of product or service, but does not specifically disclose the first product or service is a hotel reservation or airline ticket.

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Official notice is taken that conditional purchase offers for airline tickets, hotel rooms, or rental cars are old and well known in the art, see assignee's reference Walker et al (5,794,207) figure 5 (515) for the benefit of maximizing sales of products or services.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to sell airline tickets in the invention of Travor et al ('347) for the benefit of maximizing sales of products or services.

13. Claims 4, 6-7, 76, 78-79, 136, 138-139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Travor et al (5,433,347) in view of Microsoft Office 2000

Professional Edition.

As per claims 4, 76, 136.

Travor et al ('347) does not specifically disclose the use of email containing a hyperlink to a cobranded web site.

Official notice is taken that email for communications is old and well known in the art, see assignee's reference Walker et al (5,794,207) column 9, lines 52-59 for the benefit of maximizing communication options.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to communicate with email for the benefit of maximizing communication options.

Microsoft Office 2000 Professional Edition teaches, pages 450-451 embedded hyperlinks in email messages for the benefit of allowing mail recipients to quickly open a web page from an email.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to send an email message with a hypertext link to a cobranded web site for the benefit of allowing mail recipients to quickly open a web page from an email.

As per claims 6, 78, 138.

Travor et al ('347) does not specifically disclose a checkbox to defer the offer until a subsequent time.

Microsoft Office 2000 Professional Edition teaches, pages 471 and 480, a checkbox to defer the message to a later time for the benefit of allowing mail recipients to defer action on the content of an email.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to have a checkbox to defer the message to a later time for the benefit of allowing mail recipients to defer action on the content of an email.

As per claims 7, 79, 139.

Travor et al ('347) does not specifically disclose an email containing a hyperlink.

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Microsoft Office 2000 Professional Edition teaches, pages 450-451 embedded hyperlinks in email messages for the benefit of allowing mail recipients to quickly open a web page from an email.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to send an email message with a hypertext link to a cobranded web site for the benefit of allowing mail recipients to quickly open a web page from an email.

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Travor et al (5,433,347) in view of Logan et al (6,199,076).

As per claim 14.

Travor et al ('347) does not disclose inquiring as to said second product or service and receiving through an interactive voice mail feature a referral to said supplier-partner.

Logan et al ('076) teaches the equivalence of voicemail or email files, see column 3, lines 42-56 and column 6-45 for the benefit of convenience to the user.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use email or voicemail as is most convenient to the user.

Prior art made of Record

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Walker et al (5,897, 620 and 6,085,169) incorporated by reference teach conditional purchases for airline tickets and email are well known.

Walker et al (5,794,207) figure 5 (515) teaches conditional purchases of airline tickets, hotel rooms, rental cars, insurance, and mortgages are well known; further column 9, lines 52-59 teach use of telephone, facsimile, postal mail or off-line communications tools, but does not disclose voice-mail.

Cameron et al (5,832,459) teaches html pages with link/jump pages are well known.

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Nicholson (6,332,128) teaches cross marketing products is well known.

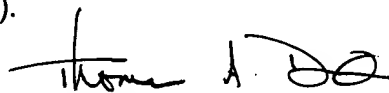
Wayne et al (EP 0 085 546) teaches a vending machine that offers a second item for a reduced price with the purchase of a first item.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon
Primary Examiner
Art Unit 3639

March 05